

## REMARKS/ARGUMENTS

Claims 1-4, 7-14 and 17-20 are now in the application. Claim 1 has been amended by deleting the original recitations concerning DNA(b) and by reentering the stringent condition found in Examples 3 and 4. Claim 2 has been amended by deleting the original recitations concerning protein (b) and replacing it with the protein (b) recitations found on page 7, lines 13-18 of the specification.

The amendments to the specification, sequence listing and claims do not introduce any new matter. Also attached is an amended machine readable sequence listing. The paper copy and the machine readable copy of the amended sequence listing are identical.

New formal drawings will be filed upon indication of the allowability of the claims.

The specification has been amended to address the objections by the Examiner.

The term "Q<sub>8</sub>" on page 17, line 16 is correct and not mistyped.

The objections to claims 1 and 2 have been overcome by the amendments to the claims.

The rejections of the claims under 35 USC 112, first and second paragraphs have been overcome by the amendments to the claims and/or are not deemed tenable. For instance, amended claim 1 recites a DNA which hybridizes with the DNA of SEQ ID NO:1 under the claimed specific stringent condition. So, this amendment has overcome the rejection of claim 1 under 35 USC 112.

Amended claim 2 recites a peptide having a homology of 60% or more to SEQ ID NO:2. So, this amendment has overcome the rejection of claim 2 under 35 USC 112.

Concerning E. Coli DH5 $\alpha$  (PNT Sa1) under FERM BP-6844 of claim 1, attached is a declaration satisfying the deposit requirements mentioned on page 9, second paragraph of the Office Action.

Claims 1-4, 7-9, 12-14 and 17-19 were rejected under 35 USC 102(b) as being anticipated by Suzuki et al (hereinafter also referred to as "Suzuki"). Suzuki fails to anticipate the above claims.

Concerning claim 1 directed to a DNA, Suzuki suggests a gene encoding the enzyme having the sequence that is only 42% identical to SEQ ID NO:2. However, this DNA does not hybridize with the DNA of SEQ ID NO:1 under the claimed specific stringent condition. Hence, Suzuki does not anticipate amended claim 1 and claims dependent therefrom.

Concerning claim 2 directed to a peptide, Suzuki suggests only the enzyme having the

sequence that is 42% identical to SEQ ID NO:2. Amended claim 2 requires homology of 60% or more to SEQ ID NO:2. Hence, Suzuki does not anticipate amended claim 2 and its dependent claims.

The cited references fail to anticipate the present invention.

In particular, anticipation requires the disclosure, in a prior art reference, of each and every recitation as set forth in the claims. See *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985), *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir. 1986), and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir. 1986).

There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 USC 102. See *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (CAFC 1991) and *Studiengesellschaft Kohle GmbH v. Dart Industries*, 220 USPQ 841 (CAFC 1984).

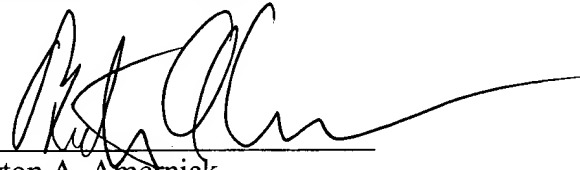
In view of the above, consideration and allowance are, therefore, respectfully solicited.

In the event that the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

The Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this communication including any extension fees to Deposit Account No. 22-0185.

Dated: 6-2-2003

Respectfully submitted,

By   
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Makoto Kawamukai

Docket No: 21581/0265

Application No.: 09/830,111

Group Art Unit: 1652

Filed: July 23, 2001

Examiner: E. Slobodyansky

For: PROCESS FOR PRODUCING COENZYME  
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DECLARATION UNDER 37 C.F.R. 1.808

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

I, Burton A. Amernick, attorney of record in the above-captioned case, hereby declare as follows.

1. *E. coli* DH5 $\alpha$  (PNT Sa 1) was deposited under FERM BP-6844 with the National Institute of Bioscience and Human Technology (Higoshi 1-1-3, Tsukuba-shi, Ibaraki, Japan) on August 17 of Heisei 11, 1990.

(a) The deposit was made under conditions that assure that:

(1) Access to the deposit will be available during the pendency of this patent application to anyone determined by the Commissioner to be entitled thereto under §1.14 and 35 U.S.C. 122.

(2) Subject to paragraph (b), all restrictions imposed by the depositor on the availability of the public to the deposited material will be irrevocably removed upon the granting of the patent.

(b) The depositor reserves the right to contract with the depository to require that samples of deposited biological material shall be furnished only if a request for a sample, during the term of the patent:

(1) Is in writing or other tangible form and dated;

(2) Contains the name and address of the requesting party and the accession number of the deposit; and

(3) Is communicated in writing by the depository to the depositor along with the date on which the sample was furnished and the name and address of the party to whom the sample was furnished.

All statements made herein of my own knowledge are true. All statements made on information and belief are believed to be true. These statements were made with the knowledge that willful false statements and the like so made are punishable by fine, imprisonment, or both, under 18 U.S.C. 1001 and may jeopardize the validity of the application or any patent issuing thereon.

The Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this communication including any extension fees to Deposit Account No. 22-0185.

Dated: *June 2, 2003*

Respectfully submitted,

By 

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